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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/771,088	02/03/2004	Ed Paver	02-285-A	1952

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09/09/2004

McDonnell Boehnen Hulbert & Berghoff

32nd Floor

300 S. Wacker Drive

Chicago, IL 60606

EXAMINER

JOLLEY, KIRSTEN

ART UNIT

PAPER NUMBER

1762

DATE MAILED: 09/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/771,088

Applicant(s)

PAVER ET AL.

Examiner

Kirsten C Jolley

Art Unit

1762

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 29-31 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 29 and 30 is/are allowed.
- 6) ☒ Claim(s) 31 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Specification

1. The disclosure is objected to because of the following informalities: The first paragraph of the specification should be updated to indicate the published patent number of the parent application.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 31 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 31, line 6, states "I is provided between the first and second sidewalls of the bearing component." It is not known what "I" is or what is meant by this limitation.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 1762

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 31 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ryan et al. (US 6,180,574) or the admitted prior art (hereinafter "APA"), taken in view of Thebault et al. (US 5,686,144).

Ryan et al. discloses a method of applying a self-lubricating coating to an inner diameter of a cylindrical /sleeve bearing component, however Ryan et al. also generally teaches that the coating may be applied to any engaging member of a bearing component (col. 1, lines 44-48 and col. 7, lines 4-10). The admitted prior art in the specification (APA) discloses a desire to applying coatings to only selected surfaces of bearing components and discloses using masking techniques to mask the sidewalls of bearing components during coating operations. One skilled in the art reading the disclosures of either Ryan et al. or the APA would have been motivated to look to the prior art for means of efficiently coating cylindrical substrates while masking the sidewalls of the cylindrical substrates provide coatings in only the desired selected areas.

Thebault et al. is directed to a method of masking the sidewalls (friction faces) of a cylindrical brake disk during a coating operation. Thebault et al. teaches coating a plurality of brake disks simultaneously via immersion by masking and sealing the friction faces/sidewalls by inserting plates 40 between the brake disks. As illustrated in Figure 5, seals 44, 48 provide a seal from the liquid coating material which is supplied to the inner and outer surfaces of the brake disks. The configuration of Thebault et al. meets the

Art Unit: 1762

limitations of claim 31. It would have been obvious for one having ordinary skill in the art to have used the masking method of Thebault et al. to mask the sidewalls of bearing components in the methods of Ryan et al. or the APA with the expectation of improved efficiency since multiple substrates are coated simultaneously, and with the expectation of successful results since Thebault et al. teaches a method of masking sidewalls of cylindrical substrates as is desired by Ryan et al. and the APA.

Allowable Subject Matter

7. Claims 29-30 are allowed. The prior art does not teach or fairly suggest a method of coating selected portions of a bearing component comprising: positioning a first bearing component in a housing between first and second seals positioned below and above, respectively, the bearing component, whereby the first and second seals cover the first and second sidewalls of the bearing component and also *provide a seal against an inner surface of the housing*; compressing the seals such that the first and second sidewalls and an outer surface of the bearing component are sealed from an inner portion of the housing; and applying a coating to an inner surface of the bearing component.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Dinh et al. (US 6,312,522) is cited for its teaching of applying a coating to a sealed substrate within an enclosure. Mino et al. (US 3,850,669) and Anderson (US 2,905,512) are cited for their teachings of coating the exterior of a plurality of cylindrical substrates simultaneously while masking the sidewalls. Karlsson


Art Unit: 1762

et al. (US 6,224,940) and Prittinen et al. are cited for their teachings of sealing one end/sidewall of a cylindrical substrate while coating the interior the substrate.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kirsten C Jolley whose telephone number is 571-272-1421. The examiner can normally be reached on Monday to Thursday and every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Shrive P Beck can be reached on 571-272-1415. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Kirsten C Jolley
Patent Examiner
Art Unit 1762

kcj